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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/062,255	04/17/98	MARAVETZ	P B0932/7088RF

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EXAMINER

VANAMAN, F

ART UNIT PAPER NUMBER

3611

18

DATE MAILED: 07/27/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application No. <b>09/062,255</b>	Applicant(s) <b>Maravetz et al.</b>
	Examiner <b>Frank Vanaman</b>	Group Art Unit <b>3611</b>

Responsive to communication(s) filed on May 12, 2000

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 1-43 and 45-78 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) 24, 33-43, 47, 49, and 50 is/are allowed.

Claim(s) 1-23, 25-32, 45, 46, 48, and 51-78 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on Apr 17, 1998 is/are objected to by the Examiner.

The proposed drawing correction, filed on May 12, 2000 is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). 16

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### **Status of Application**

1. Applicant's amendment, filed May 12, 2000 has been entered in the application. Claims 1-43, and 45-78 are pending, claim 44 having been canceled, claim 78 having been added.

### **Drawings**

2. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on May 12, 2000 have been approved.

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the third engagement member which may be operated by an actuator (claim 78) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. Please note that claim 78 is currently written to include the limitations of claim 73.

### **Claim Objections**

4. Claims 28, 29 and 78 are objected to because of the following informalities: claims 28 and 29 both recite the same limitations and depend from the same claim (claim 27) and are thus identical. One of these claims should be canceled or otherwise amended so as not to claim identical subject matter. In claim 78, line 1, the preamble of the claim does not match the preamble of the claim from which it depends. Appropriate correction is required.

### **Claim Rejections - 35 USC § 112**

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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6. Claims 1-23, 25-32, 51-72 and 74-78 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claims 1, lines 16-17; claim 51, lines 13-14; claim 53, lines 1-2; claim 54, lines 8-9 and claim 74, lines 3-4 the recitations directed to the prevention of release are not supported by the specification as filed. Applicant has referred (at page 10 of the amendment) to page 38, line 30, as providing support for this limitation, however the specification indicates that a resisting of release is provided, and not a prevention. Further note, for example, page 38, lines 24-28 or page 37, lines 2-4, wherein a releasing action is clearly described, in contradiction with the material added to the claims.

In claim 78, the newly added limitations concerning the operation of a third engagement element is also not supported by the specification (see page 36, line 26 through page 40, line 31). While the specification does teach alternate embodiments which may employ a third engagement element, applicant is reminded that claim 78 depends from and includes the limitations of claim 73, and while the specification supports the material in claim 73, it does not further support the combination which results in claim 78.

7. Claims 1-23, 25-32, 45, 46, 48, and 51-78 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, lines 16-19, claim 51, lines 13-17, claim 54, lines 8-11 and claim 74, lines 3/5 and 9-10, the recitations of a binding system which prevents release of one element from another, followed directly by a recitation describing the release of one element from another is contradictory.

In claims 45, 46 and amended claim 48, the scope is unclear: claim 33 recites a snowboard boot, which appears to be directed to a subcombination (i.e., the boot itself), while claims 45, 46

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and 48 recite further limitations to the engagement members of the binding, and particular relationships between boot portions and binding portions, which recitation appears to imply a combination of both the boot and the binding.

The examiner apologizes for failing to set forth the following claim rejection, directed to claims 51-53, under 35 USC §112, second paragraph. In claims 51-53, the scope is unclear in claim 51, lines 13-17, claim 52, lines 1-3 and claim 53, lines 1-2, while the preambles to the claims are directed to a snowboard boot suggesting a subcombination, the positive relationship recited between the two engagement members, one on the boot and one on the binding suggests a combination.

In claims 55, 64, 65, 68, and 73, again, the scope is unclear: both claim 54 and the preamble to claim 73 recite a snowboard binding, implying the subcombination of a binding itself, while claims 55 (lines 3-6), 64, 65, and 68 and claim 73, lines 9-22 are directed to further particular details of the boot element and particular relationships between the boot and binding, implying a combination of the boot and binding.

In claim 78, it appears as though applicant is attempting to include method limitations in an apparatus claim.

#### **Double Patenting**

8. Applicant's comments (page 9 of the amendment) concerning the Double Patenting rejections set forth in the previous office action have been considered. The Double Patenting rejections have been withdrawn in view of these comments, which indicate that the claims of this application and the copending applications are directed to patentably distinct inventions.

#### **Claim Rejections - 35 USC § 102**

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. Claims 1-5, 7-12, 15, 27, 30-32, 51-58, 64, 68 and 74-76 are rejected under 35 U.S.C. 102(b) as being anticipated by Bader et al. (DE 4,020,873). Bader et al. teach a binding

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system for attaching a boot (3) having a sole (10-- upper elements 4) to a gliding board (1-- lower elements 2) with a mating engagement system located at least under a toe region (figs. 1, 2) comprising upper wedge-shaped cleat elements (figs. 14, 15 for example), symmetrical about a longitudinal axis, and having narrow free ends and wide base ends, the region between the base and the base end of the wedge (e.g., upper elements, fig 15) providing a shelf which serves to engage a pair of lower mating engaging elements (lower elements, figure 15) and do not allow vertical disengagement of the boot from the binding in response to forces below a threshold which overcomes the engagement between the elements, the narrow ends of the wedges being narrower than the spacing between the lower elements so as to allow a vertically downward insertion of the boot in the binding, the engaging causing a deformation of both the lower mating elements and upper wedge elements from an undeformed, closed, position associated with the boot being disengaged from the binding to a deformed, open, position associated with the insertion of the boot in the binding, and returning to an undeformed position (a) upon seating of the boot in the binding, or (b) subsequent removal of the boot from the binding, as broadly claimed. Bader et al. further teach a connection which employs both deformation and camming action (e.g., fig. 14) which can be used to facilitate the mutual deformation of the engaging elements (31) to the same degree during both insertion and removal of the boot from the binding.

#### **Claim Rejections - 35 USC § 103**

11. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
12. Claim 77 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bader et al. The reference of Bader et al. is discussed in detail above, and fails to teach the removal of the boot as comprising a step of lifting a heel area followed by pivoting about a toe area, however the structure of the reference of Bader et al. would allow such a motion, e.g., a removal of the rear portion first, the pivoting resulting in that a forward foot portion remains temporarily anchored to

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the board, and it would be obvious to perform such a step, for example should a rider's balance be upset, resulting in a forward pitching.

#### **Response to Arguments**

13. Applicant's arguments filed May 12, 2000 have been fully considered but they are not persuasive. As regards the combination/subcombination issues as applied to the claims under 35 USC §112, second paragraph, the ambiguous recitations which do not clearly indicate whether a combination or a subcombination is being claimed remain, and while applicant's comments have indicated that this material which appears to encompass the combination is not part of the claimed subject matter, this material appears to be necessary (as evidenced by its presence in the claims in question) for defining the claimed subject matter.

Applicant's comments regarding the reference to Bader have been considered but are not persuasive. Note Bader's figure, 15, for example, which includes a structure which does not allow the release of the boot from the binding unless a substantially high threshold force is achieved, similarly, applicant's translation of the Bader reference is noted, but the references to the highly frictional engagement between the boot and binding appear to teach that the binding does not release except under the effect of a large force.

Applicant's comments directed to the references of Brechet and Romano have been considered and are persuasive, the examiner agrees that there is no reason to combine such references.

#### **Allowable Subject Matter**

14. Claims 24, 33-43, 47, 49, and 50 are allowed.

15. Claims 45, 46, 48 and 73 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

16. Claims 6, 13, 14, 16-23, 25, 26, 28, 29, 59-63, 66-72 and 78 have not been rejected as unpatentable over the prior art of record, however these claims are rejected under 35 USC §112,

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first and second paragraphs, and would not be allowable until the resolution of the first and second paragraph issues set forth in this office action.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Vanaman whose telephone number is (703) 308-0424. Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

Assistant Commissioner for Patents  
Washington, DC 20231

or faxed to :

(703) 305-3597 or 305-7687 (for formal communications intended for entry;  
informal or draft communications may be faxed to the same number but should be  
clearly labeled "UNOFFICIAL" or "DRAFT")

**FRANK B. VANAMAN**  
**Patent Examiner**  
**Art Unit 3611**

July 25, 2000



7/25/00